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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,561	03/27/2001	Larry L. Hood	155694-0054	2600

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EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/819,561	Applicant(s) HOOD, LARRY L.	
	Examiner david shay	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 15, 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-59 is/are pending in the application.
- 4a) Of the above claim(s) 5-34, 39, 48, 49, 52 and 55-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed. 53 54
- 6) ☒ Claim(s) 1-4, 36-38, 40-47, 50, 51, and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant argues that the laser of Bille et al, which changes the tissue into a “semi-liquid” state, does not denature the tissue. To delete this argument applicant has included a definition garnered from the world-wide-web. This argument is not convincing. Firstly, there is no showing that this is the definition that would have been ascribed to his term at the time the invention was made. Secondly, there is no showing that a corneal surgeon would use this definition. Further, Stedman’s Medical Dictionary (copyright 1995) defines “denatured” as “Made unnatural or changed from normal in any of its characteristics”. Thus clearly the change from the normal viscoelastic properties of the stromal tissue would qualify as being “denatured”. Applicant’s theory regarding the permanence of the change in the corneal curvature imparted by the method of Bille et al is noted, however unsupported opinions by applicant’s representative are insufficient to overcome the clear teaching of Bille et al.

Claims 55-58 are indefinite because the preamble recites a method, but they depend from an apparatus claim (claim 52). For the purposes of examination, these claims will be treated as depending from claim 53.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 45-47, 51, 53 and 54 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bille et al.

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Claims 1-3, 36-38, 40, 42, 45-47, 51, 53 and 54 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Spears et al.

Claims 1-4 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al in combination with Knopp et al. Bille et al teaches denaturing tissue. Knopp et al disclose a medical system that can denature a cornea comprising laser (item 87), a stepper motor (item 41), and a lens (items 17 and 23). It would have been obvious to employ the laser of Bille et al in the device of Knopp et al, since this provides recurvature without affecting surface tissue, as taught by Bille et al or to employ the focal point displacement mechanism of Knopp et al, since Bille et al provides no particulars of the mechanisms for moving the beam, thus producing a device such as claimed.

Claims 36-38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al in combination with Klopotek. Bille et al teaches denaturing eye tissue. Klopotek teaches configuring the intensity of an incident laser beam. It would have been obvious to the artisan of ordinary skill to employ the laser of Bille et al in the device of Klopotek, since this provides a non destructive recurvature or to employ the intensity configuring mask of Klopotek in the device of Bille et al, since it will work equally well with any laser, thus producing a device such as claimed.

Claims 1, 40, 41, 45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knopp et al in combination with Bille et al, as applied to claims 1-4 and 40 are above, and

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further in view of L'Esperance Jr. L'Esperance Jr. teaches an ocular surgery device which provides for the movement of the beam focal point in a circular pattern about the cornea at a predetermined diameter. It would have been obvious to the artisan of ordinary skill to employ a scanner with a scan pattern as taught by L'Esperance, Jr., since this is a useful pattern for ophthalmic surgery and to produce the pattern with the diameter of 6-8 millimeters, since L'Esperance, Jr. says only that the distance needs to be "predetermined" and using a distance of 6-8 millimeters would place it outside of the optically used portion of the cornea, which will prevent visual distortions as is notorious in the art, thus producing a device such as claimed.

Claims 1, 40, 41, 45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knopp et al in combination with Bille et al, as applied to claims 1-4 and 40 are above, and further in view of L'Esperance Jr. L'Esperance Jr. teaches an ocular surgery device which provides for the movement of the beam focal point in a circular pattern about the cornea at a predetermined diameter. It would have been obvious to the artisan of ordinary skill to employ a scanner with a scan pattern as taught by L'Esperance, Jr., since this is a useful pattern for ophthalmic surgery and to produce the pattern with the diameter of 6-8 millimeters, since L'Esperance, Jr. says only that the distance needs to be "predetermined" and using a distance of 6-8 millimeters would place it outside of the optically used portion of the cornea, which will prevent visual distortions as is notorious in the art, thus producing a device such as claimed.

Claims 37 and 42-44 are rejected under 35 U.S.C 103(a) as being unpatentable over Bille et al in combination with Klopotek as applied to claims 36-38 and 42 above, and further in view

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of L'Esperance, Jr. L'Esperance, Jr. teaches providing a circularly scanned spot, which denatures tissue. Thus it would have been obvious to the artisan of ordinary skill to employ the intensity modifier of Klopotek to produce the intensity pattern of the spot in the method of L'Esperance, Jr. since the outputs of laser such as used by L'Esperance, Jr. have a non-uniform intensity distribution, thus producing a method such as claimed.

Applicant's arguments filed December 15, 2004 have been fully considered but they are not persuasive. The arguments are not convincing for the reasons set forth above.

Any inquiry concerning this communication should be directed to david shay at telephone number 571-272-4773.

Shay/am

March 22, 2005



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330